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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/779,240	02/08/2001	Valery Kanevsky	10004226-1	6661

7590 11/17/2004

AGILENT TECHNOLOGIES  
Legal Department, 51U-PD  
Intellectual Property Administration  
P.O. Box 58043  
Santa Clara, CA 95052-8043

EXAMINER

MORAN, MARJORIE A

ART UNIT	PAPER NUMBER
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1631

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/779,240

**Applicant(s)**

KANEVSKY ET AL.

**Examiner**

Marjorie A. Moran

**Art Unit**

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3,7,9-14 and 35-72 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-3,7,9-14,35-59,63-67 and 69-72 is/are allowed.
- 6) ☒ Claim(s) 60-62, 68 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action. All objections and rejections not reiterated below are hereby withdrawn.

***Claim Rejections - 35 USC § 112***

Claims 60-62 and 68 are again rejected, as previously set forth in the office action of 7/2/04, under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant's arguments filed 8/19/04 have been fully considered but they are not persuasive.

The term "highest" in claims 60-61 is a relative term which renders the claim indefinite. The term "highest" is not defined by the claim with regard to a "quality" of a set of features, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Applicant argues on pages 17-18 of the response that the term "highest" is used to describe the quality of a set of features, but fails to define what a "highest quality" is intended to be. Applicant points to definitions in the specification for a "complement" and for the term "quality. It is noted that both definitions provided in the specification also use terms of degree which are not defined; i.e. a "higher quality set" and "better the quality of prediction". As it is not clear from either the claims themselves nor the specification just how much "higher" or "better" a prediction or quality of prediction must be to describe the "highest" one, the examiner maintains that one skilled in the art would not know the metes and bounds intended by applicant for the term "highest", and the rejection is maintained.

Claim 68 recites "immunological information". Neither the specification nor the claims define this phrase. In addition, the phrase may have many meanings in the art; e.g. antibody

Art Unit: 1631

titer, white blood cell count, immunodeficiency status, lymph profile, etc. As it is not clear what meaning applicant intends for this phrase, the claim is indefinite. In the response on page 19, applicant merely states that this term is to be given a broad meaning. It is noted, however, that NO definition for the term is provided anywhere in the original disclosure, and that the claim is not necessarily enabled for all meanings that could be ascribed to it in the art. For example, how does one "predict" the presence of a white blood cell COUNT, or a lymph PROFILE or an immunodeficiency STATUS using the claimed method steps? As it is still unclear what meaning applicant intends for this term, a determination of enablement will be held in abeyance until such time as the term is clearly defined. Further, as the examiner maintains that the one skilled in the art would not know what definition for this term applicant intends, the rejection is maintained. This rejection may be overcome by deleting the term "immunological information" from the claim.

#### ***Allowable Subject Matter***

Claims 1-3, 7, 9-14, 35-59, 63-67 and 69-72 are allowable.

The following is a statement of reasons for the indication of allowable subject matter and/or allowance: applicant has persuasively argued in a previous office action that the closest prior art does not teach or fairly suggest the claimed method steps. A method which determines a "best" predictor set of features for a target and/or actually predicts a target using such a set is one which recites a practical application and has utility.

#### ***Conclusion***

Claims 1-3, 7, 9-14, 35-59, 63-67 and 69-72 are allowed; claims 60-62 and 68 are rejected.

Art Unit: 1631

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marjorie A. Moran whose telephone number is (571) 272-0720. The examiner can normally be reached on Mon. to Wed, 7:30-4; Thurs 7:30-6; Fri 7-1 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (571)272-0722. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Marjorie A. Moran  
Primary Examiner  
Art Unit 1631

*Marjorie A. Moran*  
11/15/04